

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant:	Wayne C. Burton, Molly Ciliberti, Lynda C. Goodrich and Ellen Frenkel	Confirmation No.	1700
Serial No.:	10/714,582		
Filed:	November 13, 2003	Customer No.:	53049
Examiner:	Sheetal Rangrej		
Group Art Unit:	3686		
Docket No.:	1074-043US01/PB10059.00		
Title:	METHOD AND APPARATUS FOR COMPENSATING DEFIBRILLATOR OPERATORS FOLLOWING AN EVENT		

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**APPEAL BRIEF**

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief in support of an appeal from the final Office Action mailed April 1, 2009, which finally rejected claims 1-11 and 14-17, and the Advisory Action mailed July 9, 2009, which affirmed the rejection of those claims. The Notice of Appeal was filed July 29, 2009. The period for filing this Brief has been extended one month to run through October 29, 2009.

Please charge Deposit Account No. 50-1778 the amount of \$540.00 for submission of this Appeal Brief, as required by 37 C.F.R. § 41.37(a)(2) for a large entity. In addition, please charge Deposit Account No. 50-1778 the amount of \$130.00 for a one month extension of time. Please charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

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### **REAL PARTY OF INTEREST**

The Real Party of Interest is Medtronic Physio-Control Manufacturing Corporation, of Redmond, Washington.

### **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

### **STATUS OF CLAIMS**

Claims 1-11 and 14-17 are pending and are the subject of this Appeal. Claims 1-11 and 14-17 are set forth in the attached Claims Appendix. The originally filed application included claims 1-16. Claim 17 was added and claims 12 and 13 were canceled in an Amendment filed December 31, 2008.

Claims 1-11 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013613 to Haller et al. ("Haller").

### **STATUS OF AMENDMENTS**

Appellant submitted a Response and Request for Reconsideration on June 1, 2009 in reply to the final Office Action mailed April 1, 2009. In the Response, Appellant requested reconsideration of the rejection of claim 1-11 and 14-17, but did not amend the application in any way. The Advisory Action mailed July 9, 2009 indicates that the Response was considered.

Appellant has not submitted any claim amendments subsequent to the issuance of the final Office Action mailed April 1, 2009. The pending claims are those presented in the Amendment filed December 31, 2008.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 recites a method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator<sup>1</sup> for the benefit of another party to whom the operator has no duty to provide use of the defibrillator.<sup>2</sup> The method comprises receiving a pre-determined monetary amount as a premium from the operator.<sup>3</sup> The method further comprises maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount.<sup>4</sup> The contractual relationship includes a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.<sup>5</sup> The method further comprises determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time.<sup>6</sup> The method further comprises, in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.<sup>7</sup>

Independent claim 15 recites a computing system comprising means for receiving a pre-determined monetary amount as a premium from an owner of an external defibrillator.<sup>8</sup> The computing system further comprises means for maintaining a contractual relationship with the owner for a period of time in exchange for the pre-determined monetary amount.<sup>9</sup> The contractual relationship includes a requirement to compensate the owner for at least a portion of expenses incurred by the owner as a result of the external defibrillator being used.<sup>10</sup> The computing system further comprises means for determining that the external defibrillator was

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<sup>1</sup> See, e.g., Appellant's originally filed application at FIG. 1; page 5, paragraph [0027]; claim 1.

<sup>2</sup> See, e.g., *id.* at page 10, paragraphs [0010]-[0011].

<sup>3</sup> See, e.g., *id.* at claim 1; page 8, paragraph [0045]; and FIG. 5, ref. num. 504.

<sup>4</sup> See, e.g., *id.* at claim 1; page 4, paragraph [0025] - page 5, paragraph [0027]; and FIG. 3, ref. nums. 102, EA1A 1 106, and defibrillator operator 106.

<sup>5</sup> See, e.g., *id.* at claim 1; page 6, paragraph [0031] - page 7, paragraph [0031]; and FIG. 3, ref. num. 106.

<sup>6</sup> See, e.g., *id.* at page 8, paragraph [0043] and page 9, paragraph [0049]; and FIG. 5, ref. num. 510.

<sup>7</sup> See, e.g., *id.* at FIG. 3, ref. num. EA1A 1 106; and page 6, paragraph [0031]-page 7, paragraph [0033].

<sup>8</sup> See, e.g., *id.* at claim 15; page 6, paragraph [0030]; FIG. 5, ref. num. 508.

<sup>9</sup> See, e.g., *id.* at claim 15; page 8, paragraph [0043]; page 6, paragraphs [0029]-[0030]; page 4, paragraph [0025] - page 5, paragraph [0027]; and FIG. 3, ref. nums. 102, EA1A 1 106, and defibrillator operator 106.

<sup>10</sup> See, e.g., *id.* at claim 15; page 6, paragraph [0031] - page 7, paragraph [0031]; and FIG. 3, ref. num. 106.

used to at least one of monitor or treat another party during the period of time.<sup>11</sup> The computing system further comprises means for compensating the owner, in response to the determination by the means for determining and in accordance with the contractual relationship, for the expenses incurred as a result of the use of the defibrillator to at least one of monitor or treat the other party.<sup>12</sup>

Independent claim 16 recites a data processing system comprising first computing means for receiving premium payments from each of a plurality of operators of a respective one or more of a plurality of external defibrillators.<sup>13</sup> The data processing system further comprises second computing means for maintaining contractual relationships with the plurality of external defibrillator operators for a period of time in exchange for the premium payments.<sup>14</sup> Each contractual relationship comprises a requirement to reimburse the respective operator for at least a portion of costs incurred by the operator as a result of one of the defibrillators being used.<sup>15</sup> The data processing system further comprises third computing means for determining that the one of the external defibrillators was used to at least one of monitor or treat another party during the period of time.<sup>16</sup> The data processing system further comprises fourth computing means for providing reimbursement to one of the plurality of external defibrillator operators, in response to the determination by the third computing means and in accordance with the contractual relationship, for the at least a portion of the costs associated with the use of the external defibrillator during the period of time incurred by the operator.<sup>17</sup>

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Appellant submits the following ground of rejection to be reviewed on appeal:

- (1) The rejection of claims 1-11 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Haller.

<sup>11</sup> See, e.g., *id.* at page 8, paragraph [0043] and page 9, paragraph [0049]; and FIG. 5, ref. num. 510.

<sup>12</sup> See, e.g., *id.* at claim 15; FIG. 3, ref. num. EAIA 1 106; and page 6, paragraph [0031]-page 7, paragraph [0033].

<sup>13</sup> See, e.g., *id.* at claim 16; and page 6, paragraph [0030].

<sup>14</sup> See, e.g., *id.* at claim 16; page 8, paragraph [0043]; page 6, paragraphs [0029]-[0030]; page 4, paragraph [0025] - page 5, paragraph [0027]; and FIG. 3, ref. nums. 102, EAIA 1 106, and defibrillator operator 1 106.

<sup>15</sup> See, e.g., *id.* at claim 1; page 6, paragraph [0031] - page 7, paragraph [0031]; and FIG. 3, ref. num. 106.

<sup>16</sup> See, e.g., *id.* at page 8, paragraph [0043] and page 9, paragraph [0049]; and FIG. 5, ref. num. 510.

<sup>17</sup> See, e.g., *id.* at claim 16; FIG. 3, ref. num. EAIA 1 106; and page 6, paragraph [0031]-page 7, paragraph [0033].

## **ARGUMENT**

Appellant traverses the current rejection of claims 1-11 and 14-17 advanced in the final Office Action mailed April 1, 2009. For at least the reasons presented below, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Appellant's claims 1-11 and 14-17. Accordingly, Appellant respectfully requests reversal by the Board of Patent Appeals based on the arguments below. Appellant respectfully requests separate review of each set of claims argued under separate headings.

### **(1) REJECTION OF CLAIMS 1-11 AND 14-17 UNDER 35 U.S.C. § 103(A) OVER HALLER**

Claims 1-11 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haller. As discussed in more detail below, Haller fails to disclose or suggest each and every feature of Appellant's claims, and provides no rational reason for the modification of the Haller system to include such features. Thus, the rejection of the claims as being obvious over Haller was improper and should be reversed.

#### **CLAIMS 1-11, 14, AND 17**

Independent claim 1 is directed to a "method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator." Haller fails to disclose or suggest reimbursing *the operator* of an external defibrillator, as in claim 1. Haller discloses reimbursing *a patient*.<sup>18</sup> Claim 1 explicitly recites "an operator" and "another party to whom the operator has no duty to provide use of the defibrillator." A patient is different from an operator or another party to whom the operator has no duty to provide use of the defibrillator. A patient, e.g., a person requiring use of the external defibrillator, would not use the external defibrillator on himself or herself. Thus, Haller fails to disclose or suggest reimbursing the *operator* of an external defibrillator, as in claim 1.

In addition, the method of claim 1 is directed to an external defibrillator. As admitted by the Examiner,<sup>19</sup> Haller fails to disclose a method directed to an *external* defibrillator. However,

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<sup>18</sup> Haller at paragraph [0178].

<sup>19</sup> Final Office Action, mailed April 1, 2009, page 3, line 18.

the Examiner asserted that the recitation of an external defibrillator is merely a recitation of intended use that must result in a *structural* difference to patentably distinguish claim 1 from Haller. Appellant respectfully disagrees.

The Examiner's arguments regarding intended use are inapplicable to claim 1. Claim 1 recites a method. Therefore, structural differences are not dispositive to the patentability of claim 1. The method of claim 1 requires, *inter alia*, determining that the external defibrillator was used for the benefit of another party during the period of time. This and other limitations reciting an external defibrillator used for another party, i.e., other than the reimbursed operator, cannot be dismissed as intended use, and must be given patentable weight.

Assuming, *arguendo*, that structural differences are relevant to the analysis of the patentability of the method of claim 1, the MPEP provides guidance on how to determine whether elements recited in the preamble of a claim are structural limitations or statements of use:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use 'can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.'<sup>20</sup>

The MPEP provides exemplary case law in order to aid in determining whether preamble recitations are structural limitations or mere statements of purpose or use:

In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia.<sup>21</sup>

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<sup>20</sup> MPEP § 2111.02, quoting *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966.

<sup>21</sup> MPEP § 2111.02, citing *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003).

In construing the claims, the *Jansen* Court made use of the well-known rule that “a preamble is treated as a limitation if it gives life and meaning to the claim.”<sup>22</sup> The preamble of claim 1 states, “A method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator.” Like in *Jansen*, the preamble of claim 1 is “not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed.” *Id.*

Federal Circuit case law provides further guidance on how to determine whether terms in the preamble limits the claimed invention. In *Eaton Corp. v. Rockwell International Corp.*,<sup>23</sup> the Court stated, “When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”

Again, the preamble of claim 1 recites, “A method of compensating an *operator* of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator.” It is clear after reviewing the entirety of the record that the plain language of the preamble of claim 1 is a statement of the intentional purpose for which the method must be performed. For example, in addition to using the term “external defibrillator” in the preamble, Appellant uses the term “defibrillator” five times in the body of claim 1. Similarly, in addition to using the term “operator” in the preamble, Appellant uses the term “operator” six times in the body of claim 1. Appellant clearly intended that the method of claim 1 be performed in conjunction with an external defibrillator. Hence, the preamble of claim 1 gives life and meaning to the claim. Furthermore, because terms such as defibrillator and operator in the body of the claim “rely upon and derive antecedent basis from the preamble,” the preamble acts “as a necessary component of the claimed invention.”<sup>24</sup> As such, the preamble and, in particular, the phrases “external defibrillator” and “operator,” is *not* merely a statement of intended use and is instead entitled to patentable weight. Because the phrases “external defibrillator” and “operator” are entitled to patentable weight and because Haller fails to teach or suggest a method that uses an external

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<sup>22</sup> *Jansen* at 1158, quoting *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)(internal quotations omitted).

<sup>23</sup> 323 F.3d 1332, 1339, 66 USPQ2d 1271 (Fed. Cir. 2003).

<sup>24</sup> *Id.* at 1339.



defibrillator, the method of claim 1, namely a method of compensating an operator of an *external* defibrillator for expenses incurred as a result of use of the defibrillator to treat another party, i.e., other than the operator, is non-obvious over Haller.

Further, independent claim 1 recites “in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.” In other words, if it was determined that the external defibrillator was used for the benefit of the other party during the period of time in which the contractual relationship was maintained, the operator of the defibrillator is *reimbursed* for at least a portion of the expenses incurred by the operator *as a result of the defibrillator being used for the benefit of the other party*, in accordance with the contractual relationship and with the computing system. Haller, in contrast, discloses reimbursing a patient *for data*, and not for the use of the defibrillator. Haller discloses the following:

For example, if a pharmaceutical company conducting a clinical trial or study involving IMD 10 and/or a prescription drug manufactured by the company that is being used in the study wishes to purchase data from patient 5 or patient 5's IMD 10, communication module 100 and/or mobile telephone or PDA 110, and patient 5 authorizes such purchase, patient 5's pre-paid card could be credited with a number of extra magnetic pulses or extra bonus points could be stored in his behalf, by, for example, a telephone service provider. At some point patient 5 can receive a cash or other reimbursement according to the total number of bonus points he has accumulated.<sup>25</sup>

As seen in the above-quoted portion of Haller, a patient may be reimbursed for *data* from the patient or from the patient's implantable medical device (IMD). In no manner does Haller disclose reimbursing an operator for “at least a portion of the expenses incurred by the operator *as a result of the defibrillator being used* for the benefit of the other party,” as in claim 1.

Independent claim 1 also recites, “maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of

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<sup>25</sup> Haller at paragraph [0178].

the other party.” As admitted by the Examiner,<sup>26</sup> “Haller does not explicitly teach wherein the contractual relationship includes a requirement to reimburse the operator.” However, the Examiner asserted the following:

The limitation of the contractual relationship including a requirement to reimburse is a non-functional descriptive material. A clause within a contract could include a reimbursement clause, but the clause itself is a non-functional descriptive material. The invention is drawn to a contract including a clause to reimburse the operator. Any health related contract is representative of containing clauses related to reimbursement.<sup>27</sup>

The Examiner’s characterization of this limitation as non-functional descriptive material is error. Claim 1 does not recite descriptive material. Claim 1 does not recite music, literature, art, or a mere arrangement or compilation of facts or data. Claim 1 does not recite a paper with text appearing thereon.

Instead, claim 1 is directed to a *method* of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator. The method of claim 1 includes the step of maintaining a contractual *relationship* in exchange for a predetermined monetary amount. A relationship, however, is not akin to music or mere data, and is not descriptive material.

Furthermore, the limitation that the relationship includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another party clearly limits and therefore changes the recited relationship, and thus the maintaining step and the claim as a whole. The scope of claim 1 does not cover any method in which a contractual relationship is maintained, but rather those methods in which a contractual relationship that includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another is maintained. At least because this limitation of claim 1 is not non-functional descriptive material, and is admittedly not disclosed or suggested by Haller, the rejection of claim 1 was improper and should be reversed.

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<sup>26</sup> *Id.* at page 3, lines 12-13.

<sup>27</sup> Final Office Action, mailed April 1, 2009, page 3, lines 13-17.

In addition, the Examiner's assertion regarding these limitations of claim 1 is error because it ignores the explicit requirement of claim 1 that the contractual relationship is *in exchange for* the received predetermined monetary amount. In particular, the Examiner argued that paragraph [0178] of Haller discloses receiving a predetermined monetary amount, and paragraph [0191] discloses maintaining a contractual relationship. Paragraph [0178] of Haller describes use of prepaid magnetic cards by a patient to pay for services, such as checking the state of the battery of an IMD, or provision of a tachycardia intervention by the IMD. Paragraph [0191] of Haller describes "another method" whereby a patient leases or rents a module 100 or PDA 110, rather than buy them, because their prognosis is such that they would not be reimbursed, e.g., by insurance, for the full cost of such devices. These teachings of Haller are unrelated. Haller does not suggest that the prepaid card of paragraph [0178] may be used to make the rental or lease payments of paragraph [0191], or, payments in exchange for any contractual relationship. Furthermore, Haller does not suggest that the prepaid card of paragraph [0178] may be used to provide a predetermined monetary amount as a premium, as required by claim 1.

In the Response to Arguments provided in the final Office Action mailed April 1, 2009, the Examiner asserted the following:

[I]t is noted that Haller teaches that pre-paid cards could be employed with their billing and invoicing systems (i.e., contractual relationship with an insurance provider), which maintains a contractual relationship with the operator for however long the patient needs the defibrillator.<sup>28</sup>

The Examiner's assertion is incorrect. Haller states the following:

Such pre-paid cards could be employed in conjunction with telephone service providers and their billing and invoicing systems. Referring briefly to FIGS. 6A through 6C, and by way of example only, when telephone/PDA 110 establishes communication via communication system 120, the telephone service provider involved in carrying out at least some of the functions of communication system 120 can keep track of and calculate charges made using pre-paid cards by a particular patient 5. The amount of charges billed against a pre-paid card could be made dependent on the complexity of the procedures and services which are initiated by patient 5, IMD 10 and/or communication

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<sup>28</sup> *Id.* at page 7, section 17.

module 100 /mobile telephone or PDA 110. For example, a routine check of the battery state of charge of IMD 10 could cost a low number of magnetic impulses stored on the pre-paid card, while an instruction to deliver a tachycardia intervention originating from remote system 130 could cost a high number of magnetic impulses stored on the pre-paid card.<sup>29</sup>

As stated in above-quoted portion of Haller, the pre-paid cards could be used “in conjunction with telephone service providers and their billing and invoicing systems.”<sup>30</sup> This is *not* a “contractual relationship with an insurance provider,” as asserted by the Examiner. In actuality, a pre-paid calling card is a relationship between the *patient* and the *telephone service provider*. Claim 1 requires maintaining a contractual relationship with the *operator* for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party. As argued below, a patient is different from an operator or another party to whom the operator has no duty to provide use of the defibrillator.

Even if there is a contractual relationship between the patient and telephone service provider of Haller, a pre-paid calling card is not a “contractual relationship including a *requirement to reimburse* the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party,” (emphasis added) as required by claim 1. There is no requirement to reimburse with a pre-paid calling card. Instead, any costs incurred through a use of a service are debited from any remaining credits on the pre-paid card. Reimbursement requires one party to repay another party for expenses incurred. With a pre-paid card, no expenses can be incurred beyond the credits existing on the pre-paid card. As such, there is no repayment, and thus no reimbursement, involved in the transaction.

Further, independent claim 1 recites determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time. The Examiner asserted that this element was disclosed in Haller at paragraphs [0098], [0155]-[0156].

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<sup>29</sup> Haller at paragraph [0178].

<sup>30</sup> *Id.*

and [0171]. Although Haller discloses using a computing system,<sup>31</sup> for at least the reasons presented above, Haller does not disclose an external defibrillator or an external defibrillator used for the benefit of the other party during the period of time.

Further still, independent claim 1 positively recites reimbursing the operator in accordance with the contractual relationship in response to the determination that the external defibrillator was used for the benefit of the other party for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party. The Examiner argued that paragraphs [0188] and [0189] of Haller disclose this limitation. These paragraphs of Haller do mention reimbursement generally. However, these paragraphs do not suggest reimbursing *in response to a determination that a defibrillator was used*, as required by claim 1. Directly contrary to this requirement, these paragraphs suggest receiving reimbursement *prior to* provision of a therapy or other remedial action.

The Examiner also argued that it would have been obvious to use the methods of Haller for an external defibrillator because the Haller system is designed to be used for a variety of products, and that it would have been obvious to use the defibrillator of Haller for the purpose of assisting another party undergoing a medical emergency.<sup>32</sup> This argument of the Examiner is also error.

The Examiner's assertion of obviousness lacks a rational underpinning and, as such, is insufficient to support the conclusion of obviousness.<sup>33</sup> The Haller system is not designed to be used for a variety of products. Rather, Haller is specifically directed to addressing issues associated with remote programming of an implantable medical device, as indicated throughout Haller.<sup>34</sup> As such, a person of ordinary skill in the art at the time of Appellant's invention would not have considered it obvious to use a defibrillator *implanted in a patient*, as taught by Haller, *to assist another party* undergoing an emergency, as suggested by the Examiner.

For at least the above reasons, the rejection of independent claim 1 under 35 U.S.C. § 103(a) over Haller was improper and should be reversed. Claims 2-11, 14, and 17 depend from claim 1. At least by virtue of their dependency, the rejection of claim 2-1, 14, and 17 was also

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<sup>31</sup> *Id.* at paragraph [0088].

<sup>32</sup> Final Office Action, mailed April 1, 2009, page 4, lines 4-13.

<sup>33</sup> See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

<sup>34</sup> See, e.g., Haller at FIGS. 6A, 8, 9A-9B, 10A, 11A, 12A, and 13A.

improper. Appellant respectfully requests reversal of the rejection of claims 1-11, 14, and 17 under 35 U.S.C. § 103(a) over Haller.

#### **CLAIM 15**

Independent claim 15 requires a computing system comprising means for receiving a pre-determined monetary amount as a premium from an owner of an external defibrillator, means for maintaining a contractual relationship with the owner for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to compensate the owner for at least a portion of expenses incurred by the owner as a result of the external defibrillator being used, means for determining that the external defibrillator was used to at least one of monitor or treat another party during the period of time, and means for compensating the owner, in response to the determination by the means for determining and in accordance with the contractual relationship, for the expenses incurred as a result of the use of the defibrillator to at least one of monitor or treat the other party. For at least the reasons discussed above with respect to independent claim 1, the rejection of claim 15 under 35 U.S.C. § 103(a) was improper and should be reversed.

#### **CLAIM 16**

Independent claim 16 requires a data processing system comprising first computing means for receiving premium payments from each of a plurality of operators of a respective one or more of a plurality of external defibrillators, second computing means for maintaining contractual relationships with the plurality of external defibrillator operators for a period of time in exchange for the premium payments, each contractual relationship comprising a requirement to reimburse the respective operator for at least a portion of costs incurred by the operator as a result of one of the defibrillators being used, third computing means for determining that the one of the external defibrillators was used to at least one of monitor or treat another party during the period of time, and fourth computing means for providing reimbursement to one of the plurality of external defibrillator operators, in response to the determination by the third computing means and in accordance with the contractual relationship, for the at least a portion of the costs associated with the use of the external defibrillator during the period of time incurred by the

operator. For at least the reasons discussed above with respect to independent claim 1, the rejection of claim 16 under 35 U.S.C. § 103(a) was improper and should be reversed.

### **SUMMARY**

The Examiner has failed to meet the burden of establishing a *prima facie* case of nonpatentability with respect to claims 1-11 and 14-17. In view of Appellant's arguments, the final rejection of claims 1-11 and 14-17 was improper and should be reversed, and all of the pending claims should be allowed.

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## **CLAIMS APPENDIX**

**Claim 1:** A method of compensating an operator of an external defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator, the method comprising:

receiving a pre-determined monetary amount as a premium from the operator;

maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party;

determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time; and

in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.

**Claim 2:** The method of claim 1 wherein the maintaining step comprises maintaining contractual relationships with a plurality of operators.

**Claim 3:** The method of claim 2 further comprising allocating the expenses across the plurality of operators.

**Claim 4:** The method of claim 1 wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount from the operator upon purchase of the defibrillator by the operator.

**Claim 5:** The method of claim 4 wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount at a regular interval corresponding to the period of time.



Claim 6: The method of claim 5 wherein the regular interval further corresponds to a period of contract for maintenance of the defibrillator.

Claim 7: The method of claim 5 wherein the period of time is annually.

Claim 8: The method of claim 5 wherein the period of time is monthly.

Claim 9: The method of claim 4 wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount in conjunction with receipt of a lease payment for the defibrillator.

Claim 10: The method of claim 1 further comprising requesting compensation for the reimbursement from the other party.

Claim 11: The method of claim 1 wherein the period of time continues in perpetuity.

Claim 14: The method of claim 1 further comprising seeking compensation for the reimbursement from an insurance carrier associated with the other party.

Claim 15: A computing system comprising:

means for receiving a pre-determined monetary amount as a premium from an owner of an external defibrillator;

means for maintaining a contractual relationship with the owner for a period of time in exchange for the pre-determined monetary amount, the contractual relationship including a requirement to compensate the owner for at least a portion of expenses incurred by the owner as a result of the external defibrillator being used;

means for determining that the external defibrillator was used to at least one of monitor or treat another party during the period of time; and

means for compensating the owner, in response to the determination by the means for determining and in accordance with the contractual relationship, for the expenses incurred as a result of the use of the defibrillator to at least one of monitor or treat the other party.

Claim 16: A data processing system comprising:

first computing means for receiving premium payments from each of a plurality of operators of a respective one or more of a plurality of external defibrillators;

second computing means for maintaining contractual relationships with the plurality of external defibrillator operators for a period of time in exchange for the premium payments, each contractual relationship comprising a requirement to reimburse the respective operator for at least a portion of costs incurred by the operator as a result of one of the defibrillators being used;

third computing means for determining that the one of the external defibrillators was used to at least one of monitor or treat another party during the period of time; and

fourth computing means for providing reimbursement to one of the plurality of external defibrillator operators, in response to the determination by the third computing means and in accordance with the contractual relationship, for the at least a portion of the costs associated with the use of the external defibrillator during the period of time incurred by the operator.

Claim 17: The method of claim 1, wherein the expenses incurred as a result of the external defibrillator being used to benefit the other party include at least one of restoring the external defibrillator, refurbishing the external defibrillator, or replacing the external defibrillator with a different external defibrillator.

## **EVIDENCE APPENDIX**

NONE

## **RELATED PROCEEDINGS APPENDIX**

NONE